

## **REMARKS**

### **I. Status Of Pending Claims**

By this Amendment, claim 1 is amended to incorporate one change in number requested by the Examiner. Formerly allowable dependent claims 11 and 19 are amended to appear in independent form. Thus, claims 1 through 4 and 6 through 46 remain pending in this application.

### **II. Related U.S. Patent Applications**

The Examiner's attention is respectfully invited to consider the status of the related patent application; Applicant's national phase application under 35 U.S.C. §371 of PCT International Application No. PCT/IB99/00277 was issued on October 21, 2003 as U.S. Patent No. 6,634,060.

### **III. Election/Restrictions**

**First**, a Petition to withdraw the finality of the restriction requirement was previously filed, but no *Decision On Petition* has issued by the Special Program Examiner as of the date of this Paper.

**Second**, the Examiner is invited to note that this is a national phase of a Patent Cooperation Treaty application. The Examiner's reasoning is not in accordance with the Patent

Cooperation Treaty and its implementing regulations.<sup>1</sup> Under the Article VI, Clause 2 of the Constitution of the United States, “all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land ... .” PCT applications are filed under the *Patent Cooperation Treaty*, which contains its own implementing regulations. PCT Article 3(4)(iii) and 17(3)(a), together with PCT Rule 3.1 and 37 CFR §1.475.

Even if MPEP expressly stated that “the consideration of unity of invention of claims of different categories should be made without regard to the practice in national applications filed under 35 U.S.C. §111,” the Examiner’s reasoning utterly ignores the primary of the U.S. Constitution and the law of the land embodied in treaties such as the Patent Cooperation Treaty; in other words, the Examiner’s reasoning is still based on the practice in national applications filed under 35 U.S.C. §111.

Under 37 CFR §1.475(b)(1), a “product and a process specially adapted for the manufacture of said product” and under 37 CFR §1.475(b)(2), a “product and process of use of

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<sup>1</sup> The decision in *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986) held that the Patent and Trademark Office interpretation of 37 CFR 1.141(b)(2) as applied to unity of invention determinations in international applications was not in accordance with the Patent Cooperation Treaty and its implementing regulations. In the Caterpillar international application, the USPTO acting as an International Searching Authority, had held lack of unity of invention between a set of claims directed to a process for forming a sprocket and a set of claims drawn to an apparatus (die) for forging a sprocket. The court stated that it was an unreasonable interpretation to say that the expression “specifically designed” as found in former PCT Rule 13.2(ii) means that the process and apparatus have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e).

said product”, “will be considered *to have unity of invention* ... .”<sup>2</sup> Consequently, process claims 35 and 44, which are “specially adapted for the manufacture of said product” within the literal meaning of 37 CFR §1.475(b)(1), are *prima facie* endowed with *unity of invention* and must be examined.

**Third**, 37 CFR §1.145 – entitled *Subsequent presentation of claims for different invention*, places the option of election solely upon the Applicant, and not upon the Examiner. 37 CFR §1.145 provides the Examiner with no authority to declare claims withdrawn from examination. Accordingly, absent the application of 37 CFR §1.145, examination of claims 35 through 37 and 44 through 46 is required.

**Fourth**, the traversal made in the previous Response is hereby incorporated and repeated.

#### **IV. Drawings**

The Examiner stated that Fig. 1 should be designated by a legend such as *Prior Art*.

Applicant filed a Petition under 37 CFR §1.181 to withdraw the requirement to label Fig. 1 as *Prior Art*. Withdrawal of the requirement to label Fig. 1 as “Prior Art” is respectfully requested.

*Inter alia*, the Examiner’s attention is invited to consider that Fig. 1 is prepared in an

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<sup>2</sup> Nothing in 37 CFR §1.475(b)(1) requires Applicant to limit the scope of either the product or process claims; moreover, 37 CFR §1.475(b)(1) does not require that either the product claim or the process claim be written so narrowly that the process is exclusive of all products other than the product claimed.

effort to illustrate Applicant's discovery of problems plagued in the art. By identifying deficiencies or problems in the prior art and addressing those deficiencies or those problems, Applicant completes the invention. As such, Applicant's effort to identify deficiencies or other undesirable features in the art, does not constitute "Prior Art" as that term is used under 35 U.S.C. §103, and defined by 35 U.S.C. §§102(a)-(g). The sole reason given by Paper No. 20050110 for labelling Figure 1 as *Prior Art* is "only that which is old is illustrated." Nothing in any paragraph of 35 U.S.C. either supports this assertion or states that which is old is prior art. Applicant's request for withdrawal of this requirement is respectfully repeated.

### **III. Claim Rejections - 35 U.S.C. §112**

Claims 1-4 and 6-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, each pair of hinge connections make a first angle and define a plane. Since there are two pairs of hinge connections recited in claim 1, "the planes" and "each said plane" have antecedent basis. The applicant also amended claim 1 to conform with the Examiner's kindly offered suggestion. Accordingly, the basis for this rejection is rendered moot.

### **IV. Claim Rejections - 35 U.S.C. §102(b)**

Claims 1, 2, 6-10, 13, 14, 15, 17 and 38-43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Nozawa (U.S. Pat. No. 5,148,912). Applicant respectfully traverses this

rejection for the following reasons.

**First,** The Examiner asserted that the closure of Nozawa '912 illustrated in figures 6-9 anticipates the claimed closure, and further stated that, regarding the inclination of the planes of the hinge elements, the feature (*i.e.*, each of said planes is inclined relative to a central closure axis) is not recited in the rejected claims. The Examiner also argued that any axis is centrally located on the closure is a central axis to which the planes are inclined either horizontally or vertically. This assertion is immaterial; under 35 U.S.C. §102(b), the Examiner must consider each of these claims in their entireties, rather than in isolated phrases. The “planes” formed by Nozawa '912 illustrated in Figures 6 through 9 are not inclined relative to a “closure axis”. The Examiner’s attention is invited to note that in Figures 8 and 9, in the closed position, shown with solid lines in Figure 8, the two opposite sides 7a, 7b are shown parallel to one another; this is confirmed by the top view of the first embodiment in Figure 4 (Nozawa '912 fails to provide a top view of the second embodiment) where opposite sides 7a, 7b, for both *resilient belts* 7 lie perpendicular to the plane of the drawing and to the Sheet 2 of the drawing. The axis of closure must also lie perpendicular to the plane of the drawing and to the Sheet 2 of the drawing. Planes formed by opposite sides 7a, 7b, for both *resilient belts* 7 which lie perpendicular to the plane of the drawing and to the Sheet 2 of the drawing, are necessarily parallel to one another. The axis of closure, which is also perpendicular to opposite sides 7a, 7b, for both *resilient belts* 7, lies perpendicular to the plane of the drawing and to the Sheet 2 of the drawing, is therefore parallel to opposite sides 7a, 7b. Consequently, planes formed by opposite sides 7a, 7b of *resilient belts* 7 can not (i) both perpendicularly intersect

the plane of the drawing and to the Sheet 2 of the drawing and (ii) and also be *inclined relative to a central closure axis*<sup>3</sup> when that central closure axis is simultaneously parallel to opposite sides 7a, 7b of *resilient belts* 7. If the Examiner believes that either Figures 3, 4, 5, 8 or 9 of Nozawa '912 are inaccurate, the Examiner is requested to so state in subsequent Office correspondence.

Claims 1, 38 and 41 expressly recite that *each of said planes is inclined relative to a central closure axis*. (See line 12 in claim 1, line 12 in claim 38, lines 15-16 in claim 41.) Nonetheless, the Examiner improperly asserted that the above feature is not recited in the claims; clarification of the Examiner's statement is respectfully requested pursuant to 37 CFR §1.104(a) and (b).

In view of the Examiner's reasoning recited in the Office action, it is not clear why the Examiner thinks that the planes of Nozawa '912 are inclined to the closure axis. If the Examiner conceived that a "closure axis" can be a line (*i.e.*, an imaginary slant line in Figs. 6, 8 and 9 of Nozawa '912) which is different from the line (*i.e.*, closure axis A) as shown in Fig. 2 (as amended on September 25, 2004) of the present application, please consider the meaning of the term "closure axis."

"The terms of a claim will be given their ordinary meaning, unless it appears that the inventor used them differently." *ZMI Corp. V. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 6 USPQ2d 1557 (Fed. Cir. 1988). In defining the meaning of key terms in a claim, reference may be had to the specification, the prosecution history, prior art, and other claims. *Minnesota*

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<sup>3</sup> Claim 1, lines 11, 12.

*Mining & Manufacturing Co. V. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992).

Here, the “closure axis” is clearly defined in the specification and/or Fig. 2 (See “A”, in Fig. 2, which is referred to as a closure axis.)

In response to the applicant’s response filed on October 13, 2004, the Examiner merely argued that the central vertical axis depicted in the drawings is not read into the claims. The Examiner did not provide the reason why reference cannot be the specification for defining the meaning of key terms in a claim.

Even assuming that the Examiner successfully traverses the above reasoning, the Examiner’s attention is invited to consider that the ordinary or dictionary meaning of the term “axis” is (1) a straight line about which a body or geometric object rotates or may be conceived to rotate, or (2) a line about which the object is symmetric, or (3) a center line to which parts of a structure or body may be referred, or (4) an imaginary line to which elements of a work of art are referred for measurement or symmetry and the like. (*The American Heritage Dictionary of the English Languages*, 3<sup>rd</sup> ed., Houghton Mifflin Company.)

With respect to the term “inclined”, it should be noted that the ordinary and/or dictionary meaning of “incline” is “to deviate from the horizontal or vertical.” (*The American Heritage Dictionary of the English Languages*, 3<sup>rd</sup> ed., Houghton Mifflin Company.) Unlike the Examiner’s definition of “the incline angle”, an inclination angle under the ordinary and/or dictionary meaning does not include 90 degree, 180 degree, and 270 degree.

Even under the ordinary or dictionary meaning of the definition of “central closure axis”,

the planes of Nozawa '912 are not inclined relative to any conceivable central closure axis in Figs. 6-9 for the following reasons.

As shown in Fig. 8 of Nozawa '912, Nozawa '912 clearly shows that the planes are vertical. Also, Fig. 9 of Nozawa '912 more clearly shows that the plane (defined by 7a, 7c(11), 7b, and 7d(10)) in a closed position is vertical. Since the planes of Nozawa '912 in a closed position are vertical in a closed position as shown in Figs. 8 and 9, the only imaginary lines which can be inclined relative to the planes in Figs. 6, 8 and 9 of Nozawa '912 are imaginary slant lines. However, in view of the definition of the term "central closure axis" in the specification as well as the ordinary or dictionary meaning, any imaginary slant line in Figs. 6, 8 and 9 of Nozawa '912 cannot be regarded as a "central closure axis".

It should be noted that an inclination of *a plane relative to a line* (i.e., closure axis) is different from an inclination of *each line (on the plane) relative to the line* and an inclination of *a plane relative to another plane*. That is, here, the fact that some lines (i.e., 7c(11), 7d(10)) in the closed position may be inclined relative to the line of the closure axis does not mean that the plane defined by the hinge connections (i.e., 7c(11) and 7d(10)) is not inclined relative to a closure axis. Likewise, the fact that the plane defined by the hinge connections (i.e., 7c(11), 7d(10)) in the closed position may be inclined relative to another imaginary plane does not mean that the plane defined by the hinge connections (i.e., 7c(11) and 7d(10)) is not inclined relative to a closure axis.

Nonetheless, the Examiner did not traverse the applicant's reasoning, and merely repeated the conclusion that "the planes are inclined either horizontally or vertically." For the



foregoing reasons, the Examiner's anticipation rejection is not proper.

**Second**, Nozawa '912 does not teach the feature of "the two connecting elements and the two pairs of hinge connections are accessible in the mould from the inside of the closure and from the outside of the closure." Apparently, the Examiner's statement that:

"the limitation of the hinge connections being accessible in the mold from the inside of the closure and from outside the closure does not structurally limit the finished claimed product."<sup>4</sup>

Claims 1, 38 and 41 do not purport to define a "finished product." Different implementations of these claims may look quite different from one another. Nothing in any clause of 35 U.S.C. §102(b) distinguishes between "structural limitations" and other types of limitations. Consequently, the failure of fully consider these claims in their respective entireties is improper, and the finality of the rejection is premature. Moreover, the action set forth in Paper No. 20050110 is incomplete under 37 CFR §1.104(a) and (b).

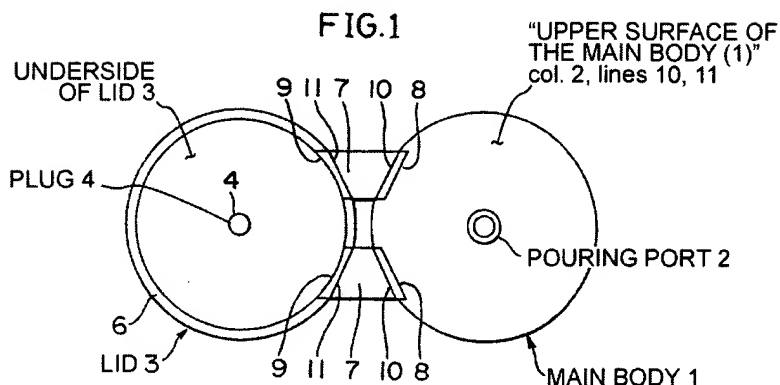
The Examiner stated that claims 1, 2, 6-10, 13, 14, 15, 17 and 38-43 are a product-by process claim, and that process limitation in a product-by-process claim is not considered for determination of patentability.

The Examiner's assertion is not proper for the following reasons. The accompanying figure taken from Nozawa '912 illustrates the first embodiment in its opened orientation in order to show the exposed upper surface of the main body (1) and the underside of lid 3, in relation to the inside surfaces of resilient belts 7.

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<sup>4</sup> Paper No. 20050110, Examiner's Comments, page 3.

# U.S. Patent No. 5,148,912



illustrate the significance of these features of the rejected claims. In Nozawa '912, *when the main body 1 and lid 3 are in their closed position*, plug 4 closes pouring port 2; necessarily, a cavity is formed between the "upper surface of the main body (1);"<sup>5</sup> What the Examiner has ignored is, among other things, the fact that connecting elements 23.1, 23.2 (*see*, for example either Figure 3 or Figure 4 of Applicant's original specification) are accessible in the mould from the inside of the closure and from the outside of the closure, as stated in these claims. The fact that this accessibility is unavailable with Nozawa '912 negates the possibility of anticipation under 35 U.S.C. §102(b), and this rejection must be withdrawn.

Moreover, returning again to the Examiner's statement that:

"the limitation of the hinge connections being accessible in the mold from the inside of the closure and from outside the closure

<sup>5</sup> Nozawa '912, column 2, lines 10 and 11.

does not structurally limit the finished claimed product,”<sup>6</sup>

the fact that process terms are used in a product claim does not necessarily mean that the claim is product-by-process claim. For example, such terms as “etched,” “welded,” “interbonded by interfusion,” and “condensation product” can be used to describe the physical characteristics of a product without changing the character of the claim into a product-by-process claim. Although those words appear to be process limitations, they are considered limitations on the structure of the invention, not words descriptive of a process. *In re Garnero*, 412 F.2d 276, 162 USPQ. 221 (CCPA 1969).

The Examiner has, in essence, disregarded the guidance provided by the Court in this decision, and erroneously asserted that the feature is of a molding process, not of a finished product. The issue is not whether the feature is a process limitation, but whether the feature is considered limitations on the structure of the invention although the words appear to be a process limitation. (See *In re Garnero*, 412 F.2d 276, 162 USPQ. 221 (CCPA 1969)).

Here, the description of the product in the mold should be regarded as a structural limitation. The shape of a mold is necessarily translated into the shape of a product. Even if the recited feature in claims 1, 38 and 41 includes the process term, the recited feature describes the physical characteristics of the product by describing the arrangement of the product.

As admitted by the Examiner and MPEP §2113, even if product-by-process claims may not be limited to the manipulation of the recited steps, product-by-process claims are limited by the structure implied by the steps. It should be noted that this case is distinguished from the

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<sup>6</sup> Paper No. 20050110, Examiner’s Comments, page 3.

case wherein the product *of the prior art* is made merely by a different process which does not imply the novel structure.

Applicant's feature of "the two connecting elements and the two pairs of hinge connections are accessible in the mould from the inside of the closure and from the outside of the closure implies the structure of the product for the above reasons. Therefore, the structure implied by the steps (*i.e.*, the feature of "the two connecting elements and the two pairs of hinge connections are accessible in the mould from the inside of the closure and from the outside of the closure") should be considered for patentability determination.

The Examiner argued that once the closure is removed from the mold, one can not determine the accessibility of the hinge connections with regard to the insider or the outside of the mold. Also, and contrary to the Examiner's assertion, the feature recited in claims can be determined from the final product. Therefore, claims 1, 2, 6-10, 13, 14, 15, 17 and 38-43 are not anticipated by the prior art.

#### **V. Claim Rejection Of Claims 3, 4 And 16 Under 35 U.S.C. §103(a)**

1. Claims 3, 4 and 16 stand rejected under 35 U.S.C. §103 as being unpatentable over Nozawa '912 in view of Dubach (US 5,392,938). Applicant respectfully traverses this rejection for the following reasons.

Supplementation of Nozawa '912 with Dubach '938 fails to remedy the deficiencies in the primary reference noted in the foregoing paragraphs.

The Examiner asserted that Nozawa '912 taught the claimed closure except for at least

one element initially connecting the two closure parts in the closed position, and that Dubach '938 taught that it was known to initially secure two hinged closure parts together.

Claims 3, 4 and 16 depend effectively from claim 1. As stated above, since claim 1 is patentable, claims 3, 4 and 16 are also patentable.

Therefore, the Examiner's rejection should be withdrawn.

#### **VI. Rejection Of Claims 18 and 20 Under 35 U.S.C. §103(a)**

2. Claims 18 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nozawa '912 in view of Altherr (U.S. Pat. No. 5,270,011) and Gach *et al.* (U.S. Patent No. 4,826,026), respectively. Applicant respectfully traverses this rejection for the following reasons.

Supplementation of Nozawa '912 with the Examiner's proposed combination of Altherr '011 and Gach *et al.* '026 fails to remedy the deficiencies in the primary reference noted in the earlier paragraphs of these remarks.

Claims 18 and 20 depend effectively from claim 1. As stated above, since claim 1 is patentable, claims 18 and 20 are also patentable.

Therefore, this rejection is technically inaccurate, and should be withdrawn. Such action is respectfully requested.

#### **Allowable Claims 11, 12 And 19**

The Examiner stated that claims 11, 12 and 19 would be allowable if rewritten to

overcome the rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. Claims 11 and 19 have been amended to stand in independent form; accordingly, claims 11, 12 and 19 are deemed to be allowed.

**Premature Rejection**

Applicant notes that the rejection under the second paragraph of 35 U.S.C. §112 was not necessitated by the previous amendment to claim 1. Consequently, designation of Paper No. 20050110 as “final” is premature. Withdrawal of this designation is respectfully requested.

**Fees Incurred**

No fees are incurred by this Amendment. Should the other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,



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